

REMARKS:

Status Of Claims

Claims 1-11 were previously pending and claims 12-23 are being added. Thus, claims 1-23 are currently pending in the application with claims 1, 7, 11, 12, 18, and 23 being independent.

Office Action

In the office action, the Examiner rejected claims 1, 2, 5-8, and 11 under 35 U.S.C. 103(a) as being unpatentable over Chisholm U.S. Patent No. 5,883,817. Specifically, the Examiner gave Official Notice that resizing windows is well known in the art and it would be obvious to modify Chisholm to include resizing of windows. Applicant respectfully traverses and requests proof of the Official Notice that resizing of windows is well known in the art of navigational devices. While Applicant agrees that resizing windows is well known in the art of personal computer operating systems, Applicant asserts that resizing windows in the art of navigational devices, as claimed in claims 1, 7, and 11, is not well known.

Additionally, Applicant asserts that personal computer operating systems and navigational devices are non-analogous arts. While both may involve computer controlled displays, these arts are directed at completely different problems. Therefore, personal computer operating systems are non-analogous art with the regard to the present invention and therefore cannot properly be used in rejecting claims to the present invention.

The applicable test for determining whether a prior art reference is properly analogous with respect to an invention considers:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the same field of the inventor's endeavor, whether the reference still is reasonably pertinent to the

particular problem with which the inventor is involved. *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

An invention cannot be considered to be within the field of endeavor of a prior art reference merely because both relate to the same industry. *Id.* 1060. However, “[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to the inventor’s attention in considering his problem”. *Id.* 1061. Patent examination, however, is necessarily conducted by hindsight, with complete knowledge and benefit of the applicant’s invention as a guide. *In re Oetiker*, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992). For this reason, it is necessary to consider the “reality of the circumstances” in deciding in which fields a person of ordinary skill in the art would reasonably be expected to look for the solution to the problem facing the inventor. *Id.* 1447. Ultimately, a rejection based on non-analogous art cannot be sustained. *Id.* 1061.

The test set forth in *In re Clay* was tellingly applied, for example, in *Wang Laboratories, Inc. v. Toshiba Corp.*, which is cited by and discussed in MPEP §2141.01(a) in the context of determining analoguousness in the electrical arts. *Wang Laboratories, Inc. v. Toshiba Corp.*, 26 USPQ2d 1767 (Fed. Cir. 1993). Wang Laboratories, Inc. (hereinafter referred to as “Wang”), as assignee, brought suit against a number of parties, including Toshiba Corp. and NEC Corp., for infringement of U.S. Patent Nos. 4,656,605 (the “605 patent”) and 4,727,513 (the “513 patent”). *Id.* 1070. These patents relate to and claim certain types of single in-line memory modules (SIMMs) (the “Wang SIMMs”). *Id.* 1770. At trial, a jury found that SIMMs manufactured by Toshiba Corp. and NEC Corp. infringed certain claims of the ‘605 and ‘513 patents. *Id.* 1770. In relevant part, Toshiba Corp. and NEC Corp. moved for JNOV, which was denied, and thereafter appealed. *Id.* 1770.

On appeal, Toshiba Corp. and NEC Corp. argued that the claims at issue were invalid for obviousness under 35 U.S.C. §103 in light of U.S. Patent No. 4,281,392

to Allen-Bradley Co. and its commercial counterpart the X9 SIMM (the “Allen-Bradley SIMM”). *Id.* 1772. Toshiba Corp. and NEC Corp. argued that the Allen-Bradley patent and the Allen-Bradley SIMM were analogous to the claimed subject matter and effective to render the relevant claims of the ‘605 and ‘513 patents invalid. *Id.* 1772.

The court held that an adequate jury instruction regarding analogous art had been provided at trial, and held that the jury’s finding of non-analogous art was supported by substantial evidence. *Id.* 1773. Specifically, the court cited the criteria set forth in *In re Clay*, and noted that “[t]he Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories … [Allen-Bradley] involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories”. *Id.* 1773. In finding substantial evidence to support the jury’s finding, the court noted that the Wang SIMMs were pertinent to the field of personal computers, and were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. *Id.* 1773. Contrastingly, the Allen-Bradley SIMMs were developed for use in a controller of much larger industrial machinery and could not be used in a personal computer. *Id.* 1773. Thus, while the Wang SIMMs were purposefully designed to be small, size was not a consideration for the Allen-Bradley SIMMs. *Id.* 1773. For these reasons, the court held, the Allen-Bradley prior art was non-analogous and not reasonably pertinent to the ‘605 and ‘513 patents. *Id.* 1773.

The test set forth in *In re Clay* was also tellingly applied, for example, in *In re Oetiker*, which is cited by and discussed in MPEP §2141.01(a) in the context of determining analogousness in the mechanical arts. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). In *In re Oetiker*, an improvement was claimed to a stepless, earless metal clamp, with the improvement being a preassembly hook which serves to both maintain a preassembly condition of the clamp and to disengage automatically when the clamp is

tightened. *Id.* 1445. All claims were rejected over the combination of U.S. Patent No. 4,492,004 to Oetiker, which disclosed the unimproved clamp, and U.S. Patent No. 3,426,400 to Lauro, which disclosed a plastic hook and eye fastener for use in garments. *Id.* 1445.

Oetiker argued during prosecution that Lauro's garment hook was non-analogous art in that a person of ordinary skill seeking to solve the problem facing Oetiker would not look to the garment art for the solution. *Id.* 1445. The Examiner argued that because garments commonly use hooks for securement, a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. *Id.* 1445. On Appeal, the Board held that Lauro was analogous art because both Lauro's and the Oetiker's inventions relate to "a hooking problem". *Id.* 1445.

The court, however, disagreed, stating that it had not been shown that a person of ordinary skill seeking to solve the problem facing Oetiker would reasonably be expected or motivated to look to fasteners for garments. Furthermore:

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. *Id.* 1446.

In the present case, according to the Examiner "[i]t would have been obvious to an artisan at the time of the invention to include the sizing/resizing windows feature [in]

Chisholm's teaching of windows and their boundaries and areas in order to allow users to customize an area of focus".

Applying the criteria of *In re Clay* as interpreted in *Wang Laboratories, Inc.* and *In re Oetiker*, personal computer operating systems are not in the same field of endeavor as the present invention merely because both broadly relate to displaying information on a display screen. Just as all memories were not the same in *Wang Laboratories, Inc.*, nor all hooking problems the same in *In re Oetiker*, all information display problems are not the same in the present case. Personal computer operating systems are non-analogous art with regard to the present invention's navigational device, and they are not made analogous merely because both involve the act of displaying information on a display screen. One with ordinary skill in the art of navigational devices would not reasonably be expected to look to personal computer operating systems to solve the problem of resizing windows that display information on a display screen. Thus, the Applicant believes that personal computer operating systems do not meet the criteria set forth in *In re Clay* and is therefore non-analogous art with regard to the present invention.

As a rejection based upon non-analogous art cannot be sustained, the Applicant respectfully asserts that the Examiner's rejections of claims 1, 7, and 11 under 35 U.S.C. §103(a) relying on the Official Notice are improper and cannot be sustained.

Furthermore, the Examiner has simply not properly supported a *prima facie* case of obviousness. Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP §

2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

The Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 USPQ 2d 1596,1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard

established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

In the present case, Chisholm does not disclose resizing windows and so the Examiner is forced to rely on the Official Notice for this feature. Again, according to the Examiner “[i]t would have been obvious to an artisan at the time of the invention to include the sizing/resizing windows feature [in] Chisholm’s teaching of windows and their boundaries and areas in order to allow users to customize an area of focus”.

Chisholm, however, clearly shows several windows, each of which display information that is continuously critical to Chisholm’s stated goal of “accurately reflect[ing] the current location, attitude **and** orientation”, as stated in column 2, lines 43-44, emphasis added. This information must continuously be updated and displayed so that, as stated in column 2, lines 59-51, “an operator [may] adjust the current location, attitude and orientation of the structure so as to align the current position with the desired position”. Thus, no one window of Chisholm’s information may become more important to a user, thereby warranting resizing of the windows, as is the case with the present invention. Therefore, Chisholm itself does not support the Examiner’s asserted motivation.

Additionally, the mere fact that a proposed modification can be made is irrelevant unless the prior art suggests the desirability of the proposed modification. *In re Fritch*, 1780, 1783-84. Therefore, as the Examiner has failed to identify a motivation for the proposed combination of teachings and the prior art does not support the desirability of the proposed modification, the Examiner has failed to establish the requisite *prima facie* case of obviousness with regard to the rejections of claims 1, 7, and 11.